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**REMARKS****INTRODUCTION:**

In accordance with the foregoing, claims 1-4 have been canceled, claim 5 has been amended, and claim 6 has been added. No new matter is being presented, and approval and entry are respectfully requested.

Claims 5 and 6 are pending and under consideration.

**REJECTIONS UNDER 35 U.S.C. § 112:**

In the Office Action, at page 2, item 3, the Examiner rejected claim 5 under 35 U.S.C. § 112, first paragraph. The reason for the rejection is set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

Applicants respectfully submit that one of ordinary skill in the art, given the specification, would have understood the portions of the specification cited by the Examiner to mean the recitation of currently amended claim 5, and that no new matter is being presented. Accordingly, Applicants respectfully submit that the Examiner's rejection is overcome.

Additionally, at page 3, item 5, the Examiner rejected claims 3-5 under 35 U.S.C. § 112, second paragraph. The reason for the rejection is set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

Claims 3 and 4 have been cancelled.

Applicants respectfully submit that the amendment of claim 5 overcomes the Examiner's rejection.

**REJECTION UNDER 35 U.S.C. § 103:**

In the Office Action, at page 5, item 6, the Examiner rejected claims 1-5 under 35 U.S.C. § 103(a) as being unpatentable over Takahashi et al. (U.S. Patent No. 5,348,123 – hereinafter Takahashi) in view of U.S. Publication No. 2002/0033638 to Okada et al. (hereinafter Okada). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration. Claim 1 has been cancelled, thus the rejection is moot. Applicants respectfully submit that the subject matter of claims 1 and 3 have been incorporated into now-independent claim 5.

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As a general matter, to establish a prima facie obviousness rejection, the Examiner needs to provide both the existence of individual elements corresponding to the recited limitations, and a motivation to combine the individual elements to create the recited invention. (See MPEP, at 2143.03, and 2143.01). Should the Examiner fail to provide evidence that the individual elements exist in the prior art, or that the motivation exists in the prior art or in the knowledge generally available to one of ordinary skill in the art, then the Examiner has not provided sufficient evidence to maintain a prima facie obviousness rejection of the claim. (See MPEP, at 2143.03, and 2143.01). Thus, the burden is initially on the Examiner to provide evidence as to why one of ordinary skill in the art would have been motivated to combine the individual elements to create the recited invention, and to demonstrate that this evidence existed in the prior art or in the knowledge generally available to one of ordinary skill in the art. (MPEP 2143.01).

The Examiner asserts that "[o]ne having ordinary skill in the art at the time of the invention would have found it obvious to have used the wheel sensor system of Okada...with the electric brake system of Takahashi...simply to provide one well known and necessary component, i.e. the wheel sensor, in ABS/TSR systems using an electric brake."

But as stated in the MPEP, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (See MPEP 2143.01).

Applicants respectfully submit that the Examiner has failed to demonstrate that evidence as to why one of ordinary skill in the art would have been motivated to combine the individual elements existed in the prior art or in the knowledge generally available to one of ordinary skill in the art.

Further, the genius of invention is often a combination of known elements that in hindsight seems preordained. When the art in question is relatively simple, the opportunity to judge by hindsight is particularly tempting. Consequently, the courts have advised that one needs to guard against falling victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. In determining obviousness, the invention must be considered as a whole without the benefit of hindsight, and the claims must be considered in their entirety. (See W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1551, 220 USPQ 303, 312-13 (Fed. Cir. 1983); see also Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983)). The courts have held that it is impermissible to use hindsight to determine obviousness, e.g., using the inventors' success as

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evidence that the success would have been expected. (See In re Kotzab, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (noting the importance of casting the mind back to the time of the invention to avoid the "insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher").

As such, Applicants respectfully submit that the Examiner's line of reasoning for combining the teachings of the references is based on improper hindsight, is unsupported by evidence, and in fact uses the teachings of the current specification. Additionally, Applicants respectfully submit that the Examiner has failed to provide evidence of a motivation that existed in the prior art and which would have motivated one of ordinary skill in the art to make the combination in the manner set forth in the office action.

The invention as defined in claim 5 recites a high precision magnetic encoder. By way of a non-limiting example, page 12 of the subject Specification discloses a multi-pole magnet 40 is of a design in which a predetermined pitch  $p$  is chosen to be not greater than, for example, 1.5 mm, with a single pitch deviation of  $\pm 3\%$ . The resulting magnetic encoder 37 is capable of detecting the number of revolutions of a vehicle wheel 1 with high precision.

Accordingly, Applicants respectfully submit that independent claim 5 patentably distinguishes over the cited art, and should be allowable for at least the above-mentioned reasons.

#### NEW CLAIM:

Applicants respectfully submit that for at least similar reasons as those stated in the section regarding the rejection under 35 U.S.C. §103, new claim 6 patentably distinguishes over the cited art and should be allowable.

#### CONCLUSION:

In accordance with the foregoing, Applicants respectfully submit that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the cited art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

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If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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For Transmittal  
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on 08 JULY, 2005  
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